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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,465	09/05/2003	Norbert Moszner	20959/2130 (P 63013)	8449

7590 08/10/2006

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EXAMINER

BUMGARNER, MELBA N

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,465	Applicant(s) MOSZNER ET AL.	
	Examiner Melba Bumgarner	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Recitation of "the hard tooth substance" lacks sufficient antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4-6, 8, 9, 11, 16, 17, 19, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Vallittu et al. (6,197,410). Vallittu et al. disclose a flexible dental polymer film comprising polymerizable groups capable of further polymerization, which film can be shaped around a tooth and cured by polymerization (figures 1,2). The film contains an acrylate or methacrylate group. At least a part of the polymerizable groups is radically polymerizable. At least a part of the polymerizable groups is cationically polymerizable. The film can comprise an

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initiator, organic or inorganic fillers, polymerization inhibitors, pigments, an antibiotic, and a primer. The film is detachably held on a carrier film that is translucent. Vallittu et al. disclose a dental polymer film and an adhesive. (columns 3-6, 8-10)

5. Claims 1-6, 8, 10, 12, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Prasad et al. (6,039,569). Prasad et al. disclose a flexible dental polymer film comprising polymerizable groups capable of further polymerization, which film can be shaped around a tooth and cured by polymerization (column 5 line 14). The film contains an acrylate or methacrylate group. The film contains polyurethanes. At least a part of the polymerizable groups is radically polymerizable. At least a part of the polymerizable groups is cationically polymerizable. The film can comprise an initiator, organic or inorganic fillers, an antioxidant, a primer, and an active substance. The film has two sides and a side of the film can have a coating of primer. (columns 3-6)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. or Prasad et al. in view of Mitra et al. Vallittu et al. or Prasad et al. disclose a dental film that shows the limitations as described above; however, they do not show the initiator in microencapsulated form. Mitra et al. teach a dental polymer comprising an initiator in microencapsulated form. It would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the film to have microencapsulated initiator in order to enhance shelf stability in view of Mitra et al.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. Vallittu et al. disclose a dental film that shows the limitations as described above and having two sides and various examples of the film as dental tooth constructions with polymeric material coating on the side facing away from the tooth surface; however, they do not show the film side with a coating of anti-adhesive additive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to call the polymeric material of Vallittu et al. an anti-adhesive as the side is not adherent.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. in view of Karazivan. Vallittu et al. disclose a dental film that shows the limitations as described above; however, they do not show the carrier film of an inflatable film bag. Karazivan teaches the film detachably held on a carrier film in the form of an inflatable film bag (page 12 line 27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the film of Vallittu et al. having the carrier film of Karazivan in order to better adapt the dental film to the applied surface.

Response to Arguments

10. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melba Bumgarner
Primary Examiner